

Appl. No. 09/745,702
Atty. Docket No. 8384
Amdt. dated August 20, 2004
Reply to Office Action of May 20, 2004
Customer No. 27752

REMARKS

Claims 1 and 6- 10 are pending in the present application. No additional claims fee is believed to be due.

The specification has been amended on page 4 lines 1. Support for this amendment can be found in the specification as exemplified by claim 10 and page 4 lines 8-22. The specification has also been amended on page 4, lines 8-22. Support for this amendment can also be found in the specification as exemplified by claim 10. The specification has further been amended on page 15, lines 8-12. Support for this amendment can be found in the specification as exemplified by claim 9. Last, the specification has also been amended on page 15, lines 13-17. Support for this amendment can be found in the specification as exemplified by page 15, lines 13-17 as originally filed.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Objections to the Drawings

The Office Action provides that between Figure 1 and Figure 3 it is unclear which of the drawings indicate an opening with an elliptical or oval shape. The Office Action further provides that the Brief Description of the Drawings section of the specification needs to be amended such that the device having an elliptical or oval opening is clearly indicated. Applicants submit herewith additional informal drawings, i.e. Figures 1A and 1B, providing the changes requested above.

Objection to the Specification

Applicants provided a previous amendment to the specification in a response to Office Action dated January 30, 2004. This previous amendment asserted that the paragraph to be amended was on lines 12-16 on page 15; however, this was erroneous. Upon further review, the amended paragraph should have been located on lines 8-12 on page 15. Therefore, herewith Applicants provide the amendment as made previously to the specification except that the amendment is proposed for page 15, lines 8-12. Applicants have also submitted herewith an amendment to the specification for page 15, lines 13-17. This proposed amendment attempts to reinstate the language of the paragraph in the originally filed application.

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The Office Action provides that the amendment filed on January 30, 2004 by the Applicants is objected to under 35 U.S.C. § 132 because it introduces new matter. The Office Action states that the added material not supported by the specification is in the paragraph beginning on page 15, lines 12-16. The language is as follows: "To facilitate the convenient handling of... receiver element positioned on a wall, tabletop, etc." and figure 1." The Office Action provides that the "amendment introduces the handle which is not supported or disclosed in the original specification."

Caselaw provides that "[t]he claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter." MPEP § 2163.06 III (citing *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985)). Applicants assert that the amendment to the specification, which calls out a handle, was claimed originally in claim 9. Thus, the handle as provided in the claims is in fact part of the disclosure as originally filed. Moreover, the handle was requested by the Office Action, dated October 30, 2003, to be placed into the drawings. See Office Action dated October 30, 2003 page 2. Therefore, Applicants assert that the specification as currently amended does not introduce new matter.

Non-statutory Double Patenting

The Office Action has rejected claims 1 and 6-10 provisionally "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-8, 11, 13-16 and 18 of copending Application No. 10/010,391." Applicants have submitted a terminal disclaimer in accordance with 37 C.F.R. § 1.321(c) herein with this response.

Rejection Under 35 USC 112, First Paragraph

The Office Action States that claim 9 stands "rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The specification has been amended such that claim 9 is adequately supported. See the amendment to the specification provided above for page 15, lines 8-12.

Rejection Under 35 USC 103(a) Over Richards et. al in view of Hamilton et. al and W.E. Meissner

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Claims 1 and 6-10 have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et. al in view of U.S. Patent No. 5,662,758 issued to Hamilton et. al and U.S. Patent No. 3,111,796 issued to W.E. Meissner.

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." See *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Furthermore, "[i]f the proposed prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). "If the proposed modification of combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *Id.* (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

The suggested combination of references does not establish a *prima facie* case of obviousness because there is no motivation to combine the suggested references. Specifically, the Office Action has failed to establish a *prima facie* case of obviousness because the Richards et. al reference teaches away from the suggested combination. Additionally, the Meissner reference renders the Hamilton reference unsatisfactory for its intended purpose and changes the principle operation of the invention taught in the Hamilton et. al reference. The Office Action provides:

Richards discloses an apparatus comprising: a body formed by an inner core having an inlet opening and an outlet opening and a passageway there between (figures 1, 4 & 5); a casing 1 comprising a surrounding casing wall, a storage space to retain a length of the flexible tubular sheet 2 within the storage

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space in a layered stack; the tubular sheet is gathered and closed at each end to form a closed packaged article 35 (figure 1); a means 61 comprises a slot for separating the closed packaged article; and the cutting blade 64 (figure 6)....

W. E. Meissner discloses, in an invention for closing and sealing a container, that: 'for closing and sealing a collapsible container by rupturing a bubble of tacky film-forming material at least within the opening end of the container as that portion of the container is urged into collapsed position' (column 1, lines 31-35). Figure 5 further depicting the closing and sealing of a flexible bag by twisting the bag at the area 53. During this twisting operation, the bubble ruptured and coated the inner wall of the bag with adhesive (column 5, lines 48-55).

Hamilton discloses a flexible film having pressure sensitive adhesive protected from inadvertent adherence (abstract); the flexible film having a recessed pressure sensitive adhesive and collapsible protrusions (three-dimensional film) which serve as stand-off to prevent premature sticking to wide variety of rigid and resilient target surfaces, wherein the collapsible protrusions are small and closely spaced for releasable sealing of the composite material to such surfaces or even to itself (column 3, lines 20-26).

W E. Meissner's teaching provides a motivation for the practitioner in the art to find a flexible material to use as a bag in which the inner surface is coated with adhesive, and when pressure is applied such as twisting, the adhesive material ensures the sealing of the closure of the bag.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Richards' tubular sheet by applying the flexible film with adhesive as taught by Hamilton providing an effective dosing and sealing of the waste article in which the flexible material having pressure sensitive adhesive that is protected from inadvertent adherence to other surfaces.

(Office Action pages 5-6).

The Office Action asserts that the Meissner reference provides a motivation to add an adhesive to a flexible material or container to ensure the sealing and the closure of a bag. However, the Meissner reference does not provide motivation to actually make the suggested combination of the Richards et. al, and Hamilton et. al references.

The Richards et. al reference, teaches a packaging device which utilizes pleated tubing to package articles. (Abstract). The Richards et al. reference teaches several methods for sealing the pleated tubing. First, the Richards et al. reference teaches that the top of the pleated tubing is pulled upward and tied into a knot thereby forming the bottom of the package. (col. 3, lines 11-

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14). Second, the Richards et al. reference teaches that after the articles are placed within the tubing, the tubing is twisted such that a seal is formed. (col. 3, lines 55-60). Third, the Richards et al. reference recommends the use of high density polyethylene because joints that are created using this material remain tight. *Id.*

Because the Richards et. al reference teaches tight seals via methods of closing the pleated tubing and materials used for the pleated tubing, there is no suggestion within the Richards et. al reference to incorporate an adhesive to ensure "the sealing of the closure of the bag." Therefore, one skilled in the art would be discouraged from applying the teachings of the Meissner reference to the Richards et. al reference.

In addition, the Meissner reference renders the flexible film of the Hamilton et. al reference unsatisfactory for its intended purpose. The Meissner reference teaches to a method of closing and sealing containers utilizing "a mass or gob of film-forming material is suspended within the open end of a container." (col. 2, lines 1-4). The gob or mass of film-forming material is "expanded into the form of a bubble, and then ruptured concomitantly as the open end of the container is collapsed." (col. 2, lines 3-5). However, "prior to the rupture of the expanded bubble of film-forming material, the bubble is deformed into conformity with the adjacent surfaces of the container walls and thereby progressively lines the same with a **continuous** adhesive coating." (col. 2, lines 9-13)(emphasis added). Thus, even prior to rupture, the expanded bubble coats adjacent surfaces of the container walls with an adhesive coating.

In contrast, an object of the Hamilton et. al reference is "to provide a composite material having a recessed **pressure sensitive** adhesive layer and collapsible protrusions which serve as stand-offs to prevent premature sticking to a wide variety of rigid and resilient target surfaces." (col. 3, lines 19-24)(emphasis added). The continuous coating of adhesive taught by the Meissner reference which is on the adjacent surfaces of the container does not preclude the premature sticking of the adjacent surfaces to target surfaces in contrast to the purpose taught in the Hamilton et. al reference. Thus, the Meissner reference does not teach a pressure sensitive adhesive and instead teaches an adhesive application which would render the composite material taught in the Hamilton et. al reference unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to suggested combination of references.

Moreover, the Meissner reference, would change the principle of operation of the prior art invention being modified, i.e. Hamilton et. al. As discussed previously, the Meissner reference teaches that a collapsible expanded bubble of film-forming material can provide a continuous

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coating of adhesive to the adjacent surfaces of a container. (col. 2, lines 5-14). According to the Meissner reference, the adjacent surfaces of the container receive at least some adhesive simply by being in contact with the adhesive bubble prior to the adhesive bubble being collapsed or ruptured.

In contrast, the Hamilton et. al reference teaches that when the collapsible protrusions are pressed they collapse such that the pressure sensitive adhesive is exposed to a target surface. (cols. 4-5, lines 65-67; 1-2). Thus, even when the composite material is in contact with a target surface, no adhesive is in contact with the target surface. Only after the collapsible protrusions are in fact depressed does the adhesive contact the target surface. Thus, the principle operation of the Hamilton et. al reference is different than the operation of the application of the adhesive in the Meissner reference. Therefore, there is no motivation to combine the suggested references.

Because the Richards et. al reference discourages the incorporation of an adhesive into the operation of sealing the pleated tubing, there is no motivation to combine the Richards et. al reference with either the Hamilton et. al reference or the Meissner reference. Moreover, because the Meissner reference renders the flexible film of the Hamilton et. al reference unsatisfactory for its intended purpose there is also no motivation to make the suggested modification to the Richards et. al reference. Also, because the Meissner reference would change the principle of operation of the prior art invention being modified, i.e. the flexible film of the Hamilton et. al reference, there is no motivation to make the suggested modification to the Richards et. al reference.

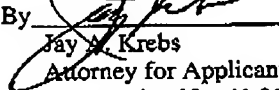
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 and 6-10.

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